

REMARKS/ARGUMENTS

Claims 7-32 and 58-63 are pending herein. Claim 7 has been amended as supported by the drawings of the application (see Fig. 4A, for example). Claims 21, 25 and 29 have been amended to correct matters of form. New claims 58-63 have been added in light of the changes to claims 21, 25 and 29. Claims 31 and 32 have been amended as supported by page 21, lines 17-24 and page 23, lines 19-24.

Claims 1-6 and 33-57 have been cancelled without prejudice or disclaimer. Applicants presently intend to file a Divisional application to pursue those non-elected claims.

1. The Examiner indicated that JP '900, JP '000, JP '272, JP '990 and JP '281, which were cited in the Information Disclosure Statements filed June 13 and June 4, 2002, have not been considered since English translations of those documents were not provided. However, the Information Disclosure Statements clearly stated that these Japanese references correspond to EP '082, EP '083, EP '363, EP '259 and EP '196, copies of which were also filed with the Information Disclosure Statements. Accordingly, the Examiner is requested to confirm that the five Japanese documents at issue have been expressly considered during the prosecution of this application.

2. Claims 13, 14, 20-29, 31 and 32 were rejected under §112, second paragraph. This rejection is respectfully traversed.

Claims 13 and 14 depend from claim 11, which in turn depends from claim 7. Claim 7 describes the steps of "supplying a solution sample containing said capture

and a solution sample containing no capture separately from each other to produce said biochip.” Applicants respectfully submit that the language of claim 7 does not specify an order in which these steps are completed. The language only requires that the steps be performed separately from each other. Dependent claim 11 further describes the non-capture solution. The sequence of the steps is first described in claims 13 and 14. Therefore claims 13 and 14 do not contradict claim 11 as the Examiner has asserted.

The rejection of claims 20-29 is noted, but deemed moot in view of the rewritten claims submitted above.

The rejection of claims 31 and 32 is noted, but deemed moot in view of the rewritten claims submitted above. The Examiner is requested to note that the word “no” in the phrase “solution sample containing no capture” from original claims 31 and 32 was deleted in the Preliminary Amendment dated May 30, 2002 (received in the PTO on June 4, 2002).

3. Claims 7-9, 11-19, 21-23 and 25-31 were rejected under §102(e) over Okamoto. To the extent that this rejection may be applied against the amended claims, it is respectfully traversed.

Amended claim 7 recites a method of producing a biochip comprising a large number of spots based on samples containing captures. The spots are arranged on the upper surface of a substantially planar base plate by supplying, onto the base plate, a plurality of types of the samples containing the captures to be used to specifically react with a specimen in order to obtain information on a structure or a function of the

specimen. The method includes the step of supplying a solution sample containing the capture and a solution sample containing no capture separately from each other to produce the biochip.

Figs. 5A, 5B, and 6 of Okamoto, show a base plate (103) having a framework (125) creating wells (127), which accept the solution being applied. Therefore, Okamoto fails to disclose solutions arranged on the upper surface of a substantially planar base plate in accordance with claim 7 of the present invention. Applicants respectfully submit that the wells are required in Okamoto, because there is no enabling disclosure in that reference of how to deposit the drops of solution in a sustainable array on the upper surface of the base plate. Applicants respectfully submit that the method of Okamoto requires the wells in order to ensure segregation among the various drops of solution making up the array.

For at least the foregoing reasons, Applicants respectfully submit that independent claim 7 defines patentable subject matter over Okamoto. Since claims 8, 9, 11-19, 21-23 and 25-31 depend either directly or indirectly from claim 7, those claims are also believed to be allowable over the applied art.

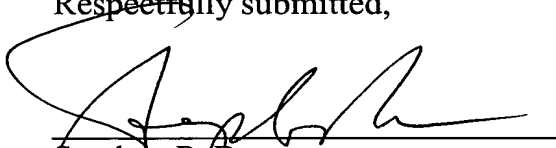
4. Claim 32 was rejected under §103(a) over Okamoto. Claim 10 was rejected under 103(a) over Okamoto in view of Robinson. Claim 20 was rejected under §103(a) over Okamoto in view of Hammond. Claim 24 was rejected under §103(a) over Okamoto in view of Dattagupta. Applicants respectfully submit that, since amended claim 7 is allowable for the reasons stated above, dependent claims 32, 10, 20 and 24 are also allowable over the applied prior art of record.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

April 27, 2005
Date



Stephen P. Burr
Reg. No. 32,970

SPB/TE/tlp

BURR & BROWN
P.O. Box 7068
Syracuse, NY 13261-7068

Customer No.: 025191
Telephone: (315) 233-8300
Facsimile: (315) 233-8320